

REMARKS/ARGUMENTS

The Office Action mailed December 20, 2005 has been reviewed and carefully considered. Claims 1-17 are pending in this application, with claims 1 and 13 being the only independent claims. Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

Claims 1-17 stand rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 5,754,656 (Nishioka).

Independent claim 1

Independent claim 1 recites “computing a first hash code for the material to be signed, the material to be signed including the form, an identifier of the form, shared information, and/or essential information” and “transferring the material to be signed and the first hash code to the mobile station”.

MPEP §2131 states that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Nishioka fails to disclose “transferring the material to be signed and the first hash code to the mobile station” because (1) Nishioka fails to disclose that the user site apparatus 10 is a mobile station and (2) Nishioka discloses that the material to be signed and the first hash is generated by the user site apparatus.

Nishioka discloses an electronic shopping method. According to Nishioka, a user site apparatus 10, i.e., a terminal, is operated by a user who has a smart card 20 (see Fig. 1, and col. 9, lines 3-6 of Nishioka). A retail store site apparatus 30 is installed in a retail store and is connected to the user site apparatus 10 by a communication line 50 for introducing various products

to the user (col. 9, lines 6-9). A credit card company site apparatus 40 is connected to the retail store site apparatus 30 by a communication line 51.

The Examiner's rejection refers to the embodiment described in cols. 21-22 of Nishioka. Accordingly, we will briefly describe that embodiment. During operation, a user inserts the smart card 20 into a slot in the user site apparatus 10 (col. 21, lines 1-3 of Nishioka). A user then selects desired products supplied from retail store site apparatus 30 and displayed on the user site apparatus 10 (col. 21, lines 5-10). The user operates an input unit such as a keyboard of the user site apparatus 10 to activate a document producing unit 102 to produce a written order P which includes a part P1 for the retail store and a part P2 for the credit card company (col. 21, lines 11-14; see also col. 10, lines 44-52). The user site apparatus 10 then produces a key K and a cipher C1 and produces a value u based on a random number r and the key K (col. 21, lines 15-32). The value u is then sent from the user site apparatus 10 to the retail store site apparatus 30 (see col. 21, lines 34-37). The retail store site apparatus 30 produces a value v based on a random number t and the value u received from the user site apparatus 10 (col. 21, lines 38-47). The value v is sent back to the user site apparatus 10 (col. 21, lines 48-51).

The user site apparatus 10 calculates a hash value $g(f(h(P1), P2), v, I)$, in which I is identification information and g , f , and h are hash functions, and supplies the hash value to the smart card 20 (col. 21, line 58 – col. 22, line 5). The smart card 20 then calculates a digital signature which is sent back to the user site apparatus 10 (col. 22, lines 6-11). The user site apparatus 10 then submits the signature, the value w and the cipher C1 to the retail store site apparatus 30.

Since Nishioka discloses that the user site apparatus 10 generates the material to be signed (written order P) and calculates the hash function, Nishioka fails to disclose "transferring the

material to be signed and the first hash code to the mobile station”, as expressly recited in independent claim 1.

The Examiner alleges in the Office Action that the step of “transferring the material to be signed and the first hash code to the mobile station” is disclosed at col. 22, lines 3-5. However, that portion of Nishioka merely states that the hash value is transferred from the user site apparatus 10 to the smart card 20. The smart card 20 is installed in a slot on the user site apparatus 10 (see col. 21, lines 1-3). Since the smart card 20 must be inserted in a slot of a terminal to be used, the smart card 20 itself can not be considered to be the mobile station recited in the claims. Accordingly, Nishioka fails to disclose the limitation “transferring the material to be signed and the first hash code to the mobile station”, as expressly recited in independent claim 1.

Nishioka also fails to disclose a mobile station. Nishioka discloses only that the user site apparatus 10 is a terminal (col. 9, lines 16-17, of Nishioka)

For all of the above reasons, independent claim 1 is not anticipated by Nishioka under 35 U.S.C. §102(e).

Independent claim 13

Independent claim 13 recites “means connected to the payment machine for the generation of the material to be signed, said material comprising a form, its identifier, shared data, and/or essential information added to it” and “means connected to the payment machine for the transfer of the material into the mobile station”, “the payment machine comprises means for computing a first hash code from the material to be signed and means for transfer of the first hash code into the mobile station”.

Nishioka fails to disclose “means connected to the payment machine for the transfer of the material into the mobile station”, “the payment machine comprises means for computing a

first hash code from the material to be signed and means for transfer of the first hash code into the mobile station” because (1) Nishioka fails to disclose that the user site apparatus 10 is a mobile station and (2) Nishioka discloses that the user site apparatus 10 generates the material and the hash code to be signed.

In the rejection of claim 13 in the Office Action, the Examiner alleges that the user site apparatus 10 of Nishioka can be considered to be the recited payment machine. However, the claims further recite that “the payment machine comprises means for verifying the authenticity of the signed and transferred material by comparing the signed hash code with the first hash code computed from the material before signature”. The Examiner states that this limitation is disclosed at col. 22, lines 42-45 and 53-58 of Nishioka. However, that portion of Nishioka describes actions performed by the retail store site apparatus 30 and the credit card company site apparatus 40. Accordingly even if, *arguendo*, the user site apparatus 10 is considered to be the payment machine recited in claim 13 (an allegation which applicant contends to be unsustainable), Nishioka still fails to disclose “the payment machine comprises means for verifying the authenticity of the signed and transferred material by comparing the signed hash code with the first hash code computed from the material before signature”.

As stated above, Nishioka also fails to disclose a mobile station. The user site apparatus 10 is merely identified by Nishioka as a terminal. Since the smart card 20 must be inserted in a slot of a terminal to be used, the smart card 20 itself can not be considered to be the mobile station recited in the claims.

Accordingly, independent claim 13 is not anticipated by Nishioka under 35 U.S.C. §102(e).

Independent claims 1 and 13 are also not obvious over Nishioka under 35 U.S.C. §103. Since Nishioka discloses that the user terminal generates the material to be signed and the hash code, there is no motivation in Nishioka for transferring the material to be signed or the hash code to the user terminal or mobile station.

In view of the above remarks, independent claims 1 and 13 are deemed to be allowable over Nishioka.

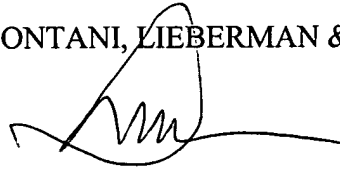
Dependent claims 2-12 and 14-17, each being dependent on one of independent claims 1 and 13, are allowable for the same reasons described above with respect to independent claims 1 and 13, as well as for the additional recitations contained therein.

For all of the above reasons, the application is now deemed to be in condition for allowance, and early notice to that effect is solicited.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE



By _____
Lance J. Lieberman
Reg. No. 28,437
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: March 20, 2006